

The Allegation of Distinct Inventions

Applicants Provisionally Elect Group I With Traverse

In response to the Office Action dated January 8, 2007 requiring restriction election, Applicants provisionally elect with traverse Group I (claims 1-18 and 20). Reconsideration and withdrawal of the restriction requirement are respectfully requested. As shown in more detail herein, the restriction requirement is without legal basis. The Action has not shown that the alleged Groups I and II are distinct from each other, but merely that they overlap in scope.

The Office Has Not Shown The Alleged Groups To Be Distinct

The Action relies on MPEP § 806.05(f) to allege that Groups II and I are related as process of making and product made. Applicants respectfully disagree. Groups I and II may be related as apparatus and process, but where is there any recitation of a product made? Also, where is there any recitation of a process of making a product? The restriction requirement is based on an invalid premise, and thus should be withdrawn.

The restriction requirement is based solely on mere allegations. The Action provides no valid reason whatsoever why the Groups are allegedly distinct from each other. The Action does not provide any valid example (evidence) of a materially different process by which the alleged product may be made, as is required in order to sustain the restriction requirement.

MPEP § 806.05 states that "The burden is on the examiner to provide reasonable examples that recite material differences." The Action alleges that "the product as claimed can be made by a materially different process such as molding it in place". However, claim 1 recites that "the picker arrangement is removably mountable". Therefore, the reason provided for

insisting on restriction is unreasonable (and not valid). As a result, the Office has not met the prerequisite criteria for insisting on restriction. The restriction requirement should be withdrawn.

Nor does the Action explain how the alleged product can be made by a materially different process from that of the Group II process claim 19, especially when the Group II process depends on the features of the Group I product. Claim 19 depends on apparatus claim 13. The restriction requirement is legally improper and should be withdrawn.

As the Office has not established that the Groups I and II are distinct from each. Therefore, Applicants respectfully submit that the restriction requirement should be withdrawn.

The Requirement Is Not Legally Proper Because There Is No Serious burden

MPEP § 803 sets forth criteria for a proper restriction requirement. One of the criteria is that there must be a "serious burden" on the examiner in order for restriction to be required. Conversely, if the search and examination of an entire application can be made without serious burden, then the examiner must examine it on the merits.

Group II (claim 19) depends on Group I. How can Group II be searched without searching for Group I? Applicants respectfully submit that the requirement is further not legally proper because the criteria for serious burden has not been met by the Office.

Rejoinder

The Action has not addressed the issue of rejoinder of claims (MPEP § 821.04). Thus, the Action is incomplete. Applicants respectfully submit that even if the claims were somehow directed to different Groups as alleged, that the process claim would still be entitled to rejoinder. Applicants reserve all rights to rejoinder.

The Basis for the Requirement is Improper

The Action's reliance on MPEP § 2173.05(p) is not applicable. Note MPEP § 2173.05(f).

The Restriction Requirement Is Without Legal Basis

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being “distinct.” The statutory authority for the Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct. Applicants respectfully disagree with the Office's interpretation of independent and distinct as set forth in MPEP § 802.01.

In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary and contrary to law in violation of the Administrative Procedures Act.

Furthermore, the Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. The Office has not established that the Groups are unrelated in design, operation, and effect. Thus, the statutory requirements are not met and no requirement is valid.

The Allegation of Patentably Distinct Species

Applicants Provisionally Elect Species B With Traverse

In response to the Office Action dated January 8, 2007 requiring restriction election, Applicants provisionally elect with traverse the alleged species B. As the requirement is best understood, at least claims 1-7, 9-18, and 20 (and 19) are readable on alleged species B. Reconsideration and withdrawal of the election requirement is respectfully requested. The requirement is without legal basis.

The Requirement Is Not Legally Proper As A Reasonable Number Of Species Are Permitted

Applicants are entitled to a reasonable number of species (i.e., more than one species). Even if it were somehow possible for the Office to show serious burden (which it hasn't), 37 C.F.R. § 1.146 still permits an application to have claims directed to a reasonable number of species. Applicants respectfully submit that even if the application had species as alleged by the Office, the alleged species would still be reasonable, especially in light of the Office's lack of any evidence to the contrary. Again, the requirement is not legally proper and should be withdrawn.

The Requirement Is Not Legally Proper As A Valid Reason For Species Election Is Absent

The Office is required to provide on the record a valid explanation as to why the alleged species are independent or distinct. For example, note MPEP § 809.02(a) at Examiner note #2 regarding form paragraph 8.01. Applicants respectfully submit that the election requirement is not legally proper because a valid explanation has not been provided to Applicants. At best, the Action (at page 3, lines 3-4) merely states "The species are independent or distinct because a text search for species A does not overlap with a text search for species B". However, unsupported statements regarding hypothetical text searches are *not* the requisite legal criteria for establishing a valid species election requirement. Where have the "mutually exclusive characteristics"

(MPEP § 806.04(f)) and the “relationship” (MPEP § 808.01(a)) of the alleged species been explained to Applicants? None have been provided. Thus, the Action procedurally fails to present a valid reason for the requirement. Again, a valid reason why the alleged species are distinct species is absent in the Action.

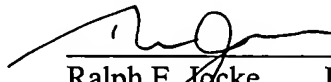
For these reasons it is respectfully submitted that there is no valid basis for requiring species election. Thus, it is respectfully submitted that the species election requirement should be withdrawn.

Conclusion

Applicants respectfully submit that the restriction and species requirements are not legally proper and should be withdrawn. Applicants, as the requirements are best understood, have provisionally elected with traverse. However, Applicants reserve all rights to change or modify their elections based on each requirement presentation being made a clearly understood and proper requirement.

The undersigned is willing to discuss any aspect of the application by phone at the Office’s convenience.

Respectfully submitted,



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